

Application No.: 10/511,322
Art Unit 3753

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 6

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-11 are now present in this application. Claims 1 and 11 are independent. By this Amendment, claims 1, 4 and 10 are amended, and claim 11 is added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 3-5 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,056,965 to Heiser. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

Claim 1, as amended, recites a valve for controlling fluid flow in a main fluid flow path, comprising a valve body having an inlet and outlet port for fluid flow from a fluid pressure source and a flexible conduit which alone forms substantially all of the main fluid flow path between the inlet and outlet ports, wherein the flexible tube also forms a valve seal closure member constrained to engage a valve seat in the closed position of the valve; a control port in the valve body for providing a control fluid acting to maintain the flexible valve seal closure member in the closed position under a pressure differential as between that applied to one side of the flexible closure member by said fluid flow through the inlet port acting to lift the flexible valve seal closure member off the valve seat, and that applied on the other side of the flexible

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 7

valve seal closure member through said control port to close the valve; and control means for varying said differential pressure to control movements of the flexible valve closure member and regulate fluid flow through the valve.

Heiser does not disclose this claimed combination of features. Heiser's main fluid flow path is defined by porous elements 50 and 52 in combination with flexible valve member 56, i.e., not substantially by flexible valve member 56 alone.

Accordingly, claim 1, as amended, is not anticipated by Heiser.

Moreover, because claims 3, 5 and 10 depend from claim 1, these claims also are not anticipated by Heiser.

Claim 4 has been amended to depend from new claim 11 and patentably defines over Heiser at least because claim 4, based on its dependency from claim 11, positively recites that the valve seat is a substantially non-porous valve seat. Heiser's valve seat, which is made up of elements 48, 50 and 52, is just the opposite, i.e., substantially porous.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the invention recited in claims 1, 3-5 and 10 by Heiser.

Reconsideration and withdrawal of this rejection of claims 1, 3-5 and 10 are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiser in view of U.S. Patent 4,300,748 to Kreeley. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 8

"the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 9

showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the Patent Office bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 10

1984). If the Patent Office fails to meet this burden, then the Applicants are entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicants to come forward to rebut such a case.

Initially, Applicants respectfully submit that claim 5, from which claims 6-8 depend, is not disclosed by Heiser, for the reasons discussed above.

Nor is Kreeley applied to remedy the aforementioned deficiencies of Heiser. So, even if one of ordinary skill in the art had a proper incentive to modify Heiser in view of the secondary reference to Kreeley, the so-modified version of Heiser would neither disclose, suggest, nor otherwise render obvious the claimed invention.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 6-8 are respectfully requested.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiser in view of Kreeley, as applied in the rejection of claim 8, and further in view of U.S. Patent 6,568,416 to Tucker et al. ("Tucker"). This rejection is respectfully traversed.

Initially, Applicants respectfully submit that claim 8, from which claim 9 depends, is not rendered obvious by Heiser in view of Kreeley for the reasons discussed above.

Nor is Tucker applied to remedy the aforementioned deficiencies of Heiser. So, even if one of ordinary skill in the art had a proper incentive to modify the Heiser-Kreeley reference combination in view of the secondary reference to Tucker, the so-modified version of Heiser-Kreeley would neither disclose, suggest nor otherwise render obvious the claimed invention.

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

RECEIVED
CENTRAL FAX CENTER

Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008

Page 11

AUG 25 2008

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claim 9 are respectfully requested.

New Claim 11

Claim 11 is added. Claim 11 corresponds to previously presented claim 1 amended to change "valve seat" to read --a substantially non-porous valve seat--. This language is inherently supported by Applicants' disclosure of valve seat 2 with solid hatching and as being made of brass or other suitable metal, or polymeric material or plastic.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

JTE/RJW:jmc:slb

Application No.: 10/511,322
Art Unit 3753

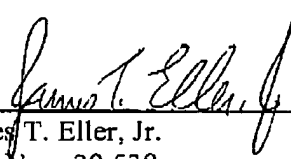
Attorney Docket No. 4140-0111PUS1
Reply to Office Action dated April 23, 2008
Page 12

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 25, 2008

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
James T. Eller, Jr.
Reg. No.: 39,538
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000
Attorney for Applicants

JTE/RJW:jmc:slb